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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,444	04/08/2004	Peter Gibson	52379/DBP/R178	7159
23363	7590	11/03/2006	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			BERTRAM, ERIC D	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	

3766

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,444

Applicant(s)

GIBSON ET AL.

Examiner

Eric D. Bertram

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 14-24, 26-32 and 35-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 25, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's reply was received in the Office on 8/18/2006, which is within the period for reply set in the last Office Action mailed on 5/23/2006. Therefore, the Notice Requiring Extension of Time Fee mailed on 8/31/2006 was not proper, and as such was withdrawn/vacated in a letter sent 10/13/2006.

Election/Restrictions

2. Applicant's election without traverse of Group I, Species A in the reply filed on 8/18/2006 is acknowledged. As a result, claims 35-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/18/06.

3. The Applicant also stated that claims 1-34 are readable thereon. However, the Restriction Requirement stated that Species A is directed to an arrangement for mounting a magnet as shown in figure 2a. However, claims 14-24 and 26-32 do not read on the arrangement shown in figure 2a. Therefore, claims 14-24 and 26-32 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. As a result, claims 1-13, 25, 33 and 34 will be examined in this Detailed Action.

The requirement is still deemed proper and is therefore made FINAL.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 10-13, 25, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Single (US 2002/0076071). Single discloses a magnetic alignment system for a transcutaneous transmitter/receiver that includes an external transmitter similar to 34 and an implantable receiver component 40 (see figure 1 and par. 0059-0060). Single further discloses that the implantable portion contains a magnet 47 positioned to assist in the alignment of the implanted coil with the external coil using magnetic attractive forces (par. 0068). Single does not specifically state that the external transmitter contains a magnet, but since magnetic attractive forces are used, the external transmitter must inherently possess a magnet, or at least something that acts as a magnet. Single further discloses that the magnet of the implantable system has an engagement surface that contacts a complementary engagement surface of silicone moulding 48 that is formed in the mounting of the implantable device (par. 0068 and figure 2). As seen in figure 2, the mounting includes a ring member 46, and the magnet is positioned within the center of the ring member.

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7. Regarding claims 2, 5, 6 and 10, figure 2 appears to show three extension member extending from the engagement surface of the magnet and connects with portions of the complementary engagement surface, as well as an inner surface of the ring member. Furthermore, figures 2a and 2b show that the extension members are the same height as the ring member, and, as a result, inherently extend from an upper surface of the ring member to a lower surface of the ring member.
8. Regarding claims 11-13, before the silicone moulding is added, the three extension members will create three wholes which are situated around the circumference of the ring member.
9. Regarding claim 25, Single discloses that the magnet is removeable from the implantable portion so that the implantee may undergo an MRI (par. 0068).
10. Regarding claims 33 and 34, Single discloses that an electrical connection is made between the implanted receiving coil and the circuitry of the implantable tissue stimulator device (par. 0069-0070). Furthermore, this connection, like all connections, is inherently detachable.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Single. Single, as described above, discloses the applicant's basic invention, including a magnet that can be removed so that the implantee may undergo an MRI scanning (par. 0068). Single does not disclose the exact structure of claims 6-9, but, upon reviewing the specification, the applicant discloses that this structure is utilized to allow removal of the magnet from the implantee during an MRI scanning (page 9, lines 5-10). Therefore, it would have been an obvious matter of design choice to modify Single by turning and locking the extension members since this arrangement is considered a

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structural equivalent based on the fact that they both perform equally well at allowing removal of the magnet from the implantee, and Applicant does not disclose how the cited structure provides any benefit over, or solves any stated problem with, the prior art.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Griffith et al. (US 6,542,777), Faltys et al. (US6,308,101) and Kuzma et al. (US 6,259,951) all discloses magnet implant systems for an implantable system.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D. Bertram whose telephone number is 571-272-3446. The examiner can normally be reached on Monday-Thursday from 8:30-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric D. Bertram
Examiner
Art Unit 3766



Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3766

EDB